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IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-502

EDWARD S. IRONS,
Petitioner,

v.

COMMISSIONER OF PATENTS,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

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COMMISSIONER OF PATENTS,
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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

Petitioner prays that a writ of certiorari issue reviewing the judgment of the Court of Appeals for the District of Columbia entered in the subject case on August 21, 1972 in supplementation of a judgment entered June 15, 1972.

THE OPINIONS BELOW

In this case the Court of Appeals for the District of Columbia delivered a first opinion on June 15, 1972 (*infra*, 1a *) which is not yet officially reported but is unofficially reported at 174 USPQ 289. Its second or "sup-

* As used herein the prefix "A" refers to the Appendix in the Court below while the suffix "a" refers to the appendix hereof.
Unless otherwise stated, all emphasis in quotations is added emphasis.

plemental opinion on petition for rehearing" was rendered August 21, 1972 (*infra*, 11a), and is not yet reported either officially or unofficially. Both decisions affirm the order of the District Court for the District of Columbia dated October 23, 1970 which is reported officially at 321 F. Supp. 628 (*infra*, 14a) and unofficially at 167 USPQ 728.

JURISDICTION

The final judgment of the Court below was entered on August 21, 1972, supplementing a judgment rendered June 15, 1972. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

QUESTIONS PRESENTED

(1) May a federal court permit an agency of the United States government to defy the clear command of 5 U.S.C. 552(a)(2) on the basis of equitable discretion in contravention of 5 U.S.C. 552(b) and (c)?

(2) Is a request for all unpublished "final opinions, including concurring and dissenting opinions and orders" couched in the very language of 5 U.S.C. 552(a)(2) *per se* a request that clearly identifies the records sought, which the agency must honor?

(3) May an agency discharge its burden under 5 U.S.C. 552(c) to justify withholding of government records by filing a controverted and partially demonstrably incorrect *ex parte* affidavit of an employee not even made on personal knowledge?

(4) Does a federal court in a case arising under 5 U.S.C. 552 have discretion simply to refuse all discovery, including even the deposition of an affiant who has made a controverted, incorrect affidavit as set forth in question 3, at the option of a government agency?

(5) May a federal court of appeals, over objection, accept as true on appeal in a case under 5 U.S.C. 552 a controverted, incorrect affidavit as set forth in question 3, even though the district court was careful not to consider it?

(6) May a federal court of appeals premise a part of its denial of relief under 5 U.S.C. 552 on grounds never raised or argued before it by either party, on which the district court made no ruling?

(7) In a case arising under 5 U.S.C. 552, must a federal court follow the mandate of Federal Rule 54(c) and grant a party any relief to which it may be entitled within the scope of its pleadings?

STATUTES AND RULES INVOLVED

The statutory provisions involved is 5 U.S.C. 552 (*infra*, 17a). This case also particularly involves each of Federal Civil Rules 12(b) and (c), 54(c) and 56(e) and (f) (*infra*, 21a).

STATEMENT OF THE CASE

This case arises under the Freedom of Information Act, 5 U.S.C. 552. It seeks compliance by a federal agency, the Patent Office, with 5 U.S.C. 552(a)(2) which directs that such agencies shall disclose publicly their rulings on cases, policy statements, interpretations, staff manuals and instructions and, subsequent to the July 4, 1967 date of the Act, shall also expedite public accessibility to these materials by maintaining public indices. Even though the statute is peremptory on its face, the Patent Office took no step toward compliance with its mandate until after the October 23, 1970 decision of the district court in this case (14a).[1]

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[1] Even then, the Patent Office proceeded only minimally to index a *part* of its apposite decisions rendered after July 4, 1967 and specifically those acknowledged to be "final" in its brief in the court below, note 1, p. 4.

Petitioner Edward S. Irons is a lawyer whose practice encompasses the representation of clients before the Patent Office. He is personally knowledgeable as to the many inequities suffered by patent applicants consequent from Patent Office suppression of the content of a substantial body of its own precedent.

Respondent is the Commissioner of Patents, charged by statute (35 U.S.C. 6) with performance of all duties imposed by law on the Patent Office.

The complaint was filed January 12, 1970, after a final Patent Office refusal (A10-11) to comply with 5 U.S.C. 552 (a) (2).[2] It included a prayer for an order:

> "(a) requiring defendant to produce the Patent Office records which have been improperly withheld from the plaintiff by defendant's denial of plaintiff's request for the production thereof;
>
> "(b) requiring the defendant to maintain and make available for public inspection and copying a current index of manuscript decisions as required by 5 U.S.C. 552(a) (2);
>
> "(c) enjoining the defendant from continuing to withhold from plaintiff and from the public the 'manuscript decisions' which are the subject of plaintiff's request to defendant;
>
> "(d) for such other relief as to the Court may appear appropriate." (A7)

The "records" sought in paragraph (a) of the prayer are defined in Paragraph 6 of the complaint in the very words of 5 U.S.C. 552(a) (2) (A) as follows:

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[2] The Patent Office refusal is on two grounds: "cannot be identified" and "cannot be disclosed because barred by 35 U.S.C. 122" (A11). The latter ground was not decided by the district court and was not briefed by either party on appeal. It is purportedly "decided" summarily and adversely to petitioner in both the June 15 decision (see 8a) and the August 21 supplemental decision of the court below (see 12a-13a).

"6. A substantial portion of the '*final opinions, including concurring and dissenting opinions and orders*' [5 U.S.C. 552(a)(2)(A)] to which reference is made in paragraph 4 of this complaint are not 'promptly published' nor are copies thereof 'offered for sale' as specified in 5 U.S.C. 552(a)(2). These unpublished 'final opinions . . . etc.' are and for many years have been identified by the defendant as 'manuscript decisions'." [3] (A5)

Paragraph 7 additionally seeks "such indices as are available" (A6). Respondent's answer (A13-14) was filed April 6, 1970 and raised six numbered affirmative defenses as follows:

(1) failure to state a claim on which relief can be granted (A13).

(2) an alleged bar consequent from 35 U.S.C. 122 (A13).

(3) the complaint "is barred in that the records are not identifiable as required by 5 U.S.C. 552(a)(3)" (A13).

(4) an alleged bar consequent from 5 U.S.C. 552(b)(3) and 5 U.S.C. 552(b)(4) (A13).

(5) the complaint "is barred in that 5 U.S.C. section 552(a)(2)(A) requires that the agency shall make available final opinions and final orders only" (A13).

(6) a "defense" combining respondent's specific pleas to the numbered paragraphs of the complaint (A13-14).

Petitioner on April 29, 1970 timely sought under Rule 33 to explore all of these defenses by interrogatories

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[3] Defendant in a controverted *ex parte* affidavit has contended that some of the manuscript decisions are not "final" but "procedural" in that they relate to "interpretation of Patent Office rules." Defendant has *never denied* that the "procedural" decisions fall within 5 U.S.C. 552(a)(2)(B) and hence within the statutory mandate for public inspection and copying but seems to believe, notwithstanding the clear language of paragraphs (a), (c) and (d) of the prayer that 5 U.S.C. 552(a)(2)(B) relief is outside the scope of the case.

(A15-20). Respondent did not trouble to answer or object to these interrogatories but instead moved on May 12, 1970 "for a protective order" excusing him from "objections or answers" pending disposition of a *prospective* motion "to dismiss or for summary judgment" (A21).[4]

On May 18, 1970 petitioner moved under Rule 37(a) for an order directing defendant to answer the interrogatories (A21) and, after considerable difficulty,[5] succeeded in obtaining a brief hearing on June 1, 1970. At that hearing the district court flatly refused to permit discovery and ruled that "the [*prospective*] motion to dismiss takes precedence over all other motions" (A35).

Subsequently on June 2, 1970 respondent moved (a) under Rule 12(b)(6) to dismiss for lack of jurisdiction and failure to state a claim on which relief can be granted and (b) "alternatively" under Rule 56 "on the ground that there is no genuine issue of material fact and defendant is entitled to judgment as a matter of law" (A37). The alternative Rule 56 motion was supported by exhibits including an *ex parte* opinion affidavit of Raymond E. Martin, Associate Solicitor of the Patent Office (A37-9), stating conclusions and inferences derived from an alleged "survey" of some *but not all* of the very unpublished decisions sought in the complaint.

The *ex parte* Martin affidavit *acknowledged contrary to Patent Office interest*, that 1853-1954 decisions exist in "175 large bound volumes, in chronological order . . . numbered in that order", each containing "an alpha-

[4] "The Government's basic position in cases under 5 U.S.C. 552" is to foreclose discovery while seeking summary dismissal. See the affidavit of Jeffrey Axelrad dated June 23, 1972 which is attached to petitioner's "Renewed Motion to Vacate Judgment and Withdraw Opinion . . ." filed July 31, 1972 in the court below.

[5] The difficulties so encountered are detailed at length in petitioner's "Brief on Appeal" below, pp. 6-7, and are further reflected at (A21-31).

betical index at the beginning" (A38).[6] It also acknowledged, contrary to respondent's interest, that the decisions sought consist of final "substantive" decisions rendered under 35 U.S.C. 134 or 135[7] and "procedural" decisions "... relating to interpretation of the Patent Office rules" (A38).[8]

The Patent Office argued that it would be burdensome to assemble the decisions because *all* Patent Office files would have to be searched. However, the Martin affidavit does not clearly so state but invites this inference through inclusion of self-serving averments as to the number of files involved (A39, Par. 9) and the alleged failure of the Patent Office to maintain a "formal file . . . separate from the files of the cases in which the decisions were written" (A38-9, Par. 7). The affidavit also contains controverted self-serving averments regarding an assumed relevance of 35 U.S.C. 122 (A39, Par. 8).

Petitioner responded by controverting the Martin affidavit on grounds arising under Rules 56(e) (A51-6, Par. 12-14) and (f) (A41-51, Par. 4-11). Petitioner, *inter alia*, sought discovery including but not limited to, an opportunity to take Martin's oral deposition before his affidavit should be considered for any purpose, evidentiary or otherwise, except as it contained the sworn admissions against interest above noted.

Petitioner further specifically controverted each and every self-serving *ex parte* allegation by Martin, including representations inferentially raised as to any supposed need to search *all* Patent Office files to comply with the statute (see especially A53, Par. 13(d)).

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[6] Hence, clearly already identified, as well as "identifiable".

[7] Hence, within 5 U.S.C. 552(a)(2)(A).

[8] Hence, clearly within 5 U.S.C. 552(a)(2)(B). See also note 3, *supra*, p. 5.

Petitioner's papers opposing the motion to dismiss and the alternative Rule 56 motion were filed on June 22, 1970. Despite a June 1, 1970 promise by the district court (A35-6) to hold a hearing before July 1, 1970, no hearing was granted until after petitioner applied for a writ of mandamus directing a prompt hearing and ruling.[9] A scheduled "status report" for September 21, 1970 was then precipitately and without adequate notice to petitioner converted into a "hearing", with the result that petitioner had no practical choice but to forego oral argument and stand on the June 22, 1970 papers opposing the motion (A61-2).[10]

On October 23, 1970 the district court issued its order granting the relief sought by paragraph (b) of the prayer and otherwise dismissing the complaint as follows:

> "In view of the fact that it seems probable that some of the manuscript decisions should be made available under the Act if a reasonable request for specific information is made, it is by the Court this 23rd day of October, 1970,
>
> "ORDERED that the United States Patent Office maintain and make available for public inspection and copying a current index providing identifying information for the public as to the unpublished manuscript decisions of the Patent Office since July 4, 1967, insofar as the same is required by 5 U.S.C. § 552(a)(2). The Court makes this order so that

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[9] *Irons* v. *Gasch*, No. 24,587, dismissed as "moot" on September 30, 1970 (see also A57-60).

[10] This action provoked respondent to seek leave to file additional papers to which petitioner objected (A64). The latter objection was unfairly lifted out of context by the court of appeals in note 7 of its June 15 opinion (9a) and distorted, contrary to fact, into an alleged acquiescence in both the district court's consistently vigorously challenged denial of discovery and the challenged, at least partially incorrect, Martin affidavit.

the public will have an adequate basis on which to make reasonable specific requests of the Patent Office. The Patent Office may deny the request for production of manuscript decisions on other grounds specified in 5 U.S.C. § 552(b) (i.e., trade secret).

"The Court, however, finds the request in the present case too broad to be identifiable and for that reason, it is by the Court

"ORDERED that the defendant's motion to dismiss be granted except insofar as has already been ordered in regard to the maintenance of a current index." (16-17a)

This dismissal is specifically premised upon respondent's third defense (A13, *supra*, p. 5). Respondent's first defense (A13) and its jurisdictional plea (A37) are both implicitly rejected. In addition, the district court was careful to avoid any ruling on the merits of the case including the second, fourth, fifth and sixth defenses and the summary judgment. The district court especially stated that:

"The Court makes no finding as to whether or not these manuscript decisions are final opinions or whether or not they contain excludable trade secret materials." (17a)

Other portions of the opinion make it very clear that the district court made *no* fact findings even on the third defense and specifically did not pass upon *any* aspect of the controverted facts. Instead, the dismissal is clearly under Rule 12(b)(6) only and premised on a constricted view of what constitutes "identifiable records". Thus, the district court said:

"The request in the instant case 'for all unpublished manuscript decisions' is not a reasonable request for identifiable records, but rather a broad, sweeping, indiscriminate request for production lacking any specificity. 'All decisions' is not a reason-

ably identifiable description, any more than asking for all the books in a particular library or all of the unpublished opinions of the United States District Court. The plaintiff has not shown that he has been denied any reasonable request for specific materials—but only a general request for all opinions, some of which may be excludable as trade secret and some of which may not be. It may be true that some of these opinions could be made available under the provisions of the Act if a specific request for an identifiable opinion were made, but a request for all is not specific enough to decide if any particular decision or decisions can be made available.

"The papers presented indicate that it is arguable that some of the requested materials contain trade secrets excludable under 5 U.S.C. § 552(b)(4) or 35 U.S.C. § 122. This Court is not required to examine every manuscript decision of the past 100 or more years to decide in each case if there is trade secret or other material which should be excluded. The legislative history of the Act indicates that it was not the intent of Congress to add materially to the burden of overworked courts. (See 1966 U.S. Code Cong. and Adm. News, pp. 2418-19.) In the case of a specific request for production that had been denied by the Patent Office, the Court could reasonably be expected to examine the claim of exclusion to see if there were any basis. *Grumman* indicated that in some instances where there is a claim of exclusion on the basis of confidentiality that the identifying data could be stricken before the materials were produced." (15-16a)

Petitioner's appeal, limited to the grant of the motion to dismiss, was filed on October 26, 1970.

Briefing on the merits in the court of appeals was completed by March 22, 1971. Oral argument was held nearly a year later on March 7, 1972, notwithstanding

two efforts by petitioner to obtain the prompt hearing seemingly afforded by 5 U.S.C. 552(a)(3), final sentence.

In its June 15, 1972 decision, the court of appeals specifically accepted as true the controverted Martin affidavit and affirmed the district court's holding that the complaint fails to seek "identifiable records". In addition, the court of appeals, *sua sponte*, decreed that Patent Office decisions on pending patent applications are "required to be kept confidential by 35 U.S.C. Section 122" (8a), despite the failure of the district court to rule on respondent's second defense and the consequent failure of either party to brief it on appeal.[11] Finally, on the pretext that the district court's dismissal was not unqualified, the court of appeals remanded for consideration of whether "existing indices" to the 175 bound volumes of decisions should be produced, thus abrogating its own duty under Rule 54(c) to rule on the point.[12]

At this juncture, petitioner sought rehearing plus withdrawal of the opinion and vacation of the judgment, pointing out that the ruling is in conflict with existing decisions of the same and other courts of appeals rendered under 5 U.S.C. 552(a)(2) and (a)(3). Petitioner

[11] By this convenient conclusion, reiterated in its August 21, 1972 opinion, the court of appeals evaded the fact that some decisions after July 4, 1967, having been located and indexed pursuant to the order of the district court (16a), had necessarily *been identified* and *were* hence *"identifiable"*—a circumstance which should have mandated partial relief under Rule 54(c). Equally ignored was the fact that 175 bound volumes of 1853-1954 decisions are *a fortiori* admittedly identified, "identifiable" and even easily transportable to a public reading room on the briefest notice, with the result that partial relief under Rule 54(c) was in order in this respect.

[12] Petitioner is unaware of the basis of the court's statement that a need exists for resolution of "facts regarding these indices" (9a). Petitioner's position is and has been that these indices have been identified and are subject to production under the statute, respondent having advanced *no* justification for withholding them.

also emphasized that the decision is at variance with the record facts in numerous respects, including its acceptance as true of demonstrably incorrect and controverted portions of the Martin affidavit.[13]

The court below thereupon delivered its "supplemental opinion on petition for rehearing" on August 21, 1972. In that decision, it reluctantly conceded that a request for agency materials in the language of 552(a)(2) *would* relate to "identifiable records" but found the complaint in this case to seek broader relief and hence adhered to its dismissal, again ignoring Rule 54(c). The decision is further remarkable in postulating a non-existent factual situation which finds no response in any part of the record, including the controverted Martin affidavit,[14]

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[13] For example, the June 15 decision accepts as true paragraph 9 of the Martin affidavit. Yet it is clear as demonstrated, *inter alia*, at pages 9 through 11 of appellant's "memorandum in support of . . . motion to withdraw opinion and vacate judgment" filed June 26, 1972 that paragraph 9 is totally incorrect.

Moreover, while the court of appeals acknowledged that petitioner disputed "that it would be necessary for the Patent Office personnel to inspect each of the allegedly more than 3,500,000 files referred to in . . . the affidavit" (4a), the significance of this dispute was completely overlooked. As said in petitioner's reply brief below,

> "The 'burden' argument rests mainly upon the *controverted* speculation that the Patent Office would have to search five million files to find the requested decisions. Plaintiff, if given the opportunity, expects to prove this speculative deduction is *not true*. See paragraph 13(d) of plaintiff's Rule 56(e) averments below (A53-54). The Martin affidavit's own averments *admit* that the 1853-1954 decisions are collected in 175, more or less, bound volumes. Allegedly, the Commissioner is preparing a partial 1967-1971 index. The files, if any, to be searched would, *at most*, span the 1955-July 4, 1967 period plus those containing the unindexed decisions for 1967-1971—a fully *reasonable* search." (pp. 10-11) (Emphasis in original)

[14] To wit, that all Patent Office decisons "not part of pendng patent applications are now public records" (12a). This finding, made *de novo* and absent supporting evidence by the court of appeals, is simply *not true*.

as a convenient justification for refusing *all* relief. The suggestion is then made that the district court may release existing "compilations", presumably including the 175 bound volumes of 1853-1954 decisions, providing "a properly framed request for these" (13a) is made and "exploration of the facts" (13a) shows this to be justified. In short, a burden to justify production has been judicially imposed on petitioner contrary to the statute.

REASONS FOR GRANTING THE WRIT

Questions 1 and 2 are concerned with an issue which far transcends the bounds of 5 U.S.C. 552—to wit: whether equitable discretion may be invoked to relieve an agency of the "burden" of compliance with a mandatory statute of unquestioned constitutionality. The issue is of great public significance because the lower federal courts, agencies and private citizens need to know the extent of Congressional power to regulate agency conduct. There is a conflict in the circuits and a confusion in the court below as to whether equitable discretion may be invoked either to excuse non-compliance with 5 U.S.C. 552 specifically or, more generally, as an excuse for avoidance of any ministerial duty imposed by statute. These conflicts should be resolved now.

Questions 3 through 6 are particularly concerned with the interpretation to be placed upon the government's burden under 5 U.S.C. 552(c) to justify withholding from the public of government information and with the related issue of whether the normal procedural safeguards afforded by various federal civil rules and principles of appellate review apply equally in Information Act cases. The decision below conflicts directly with previous interpretations of 5 U.S.C. 552(c) in other courts and with the application of the federal rules and appellate review principles to other forms of civil litigation. There is a danger that this case below may become a

model (or "test") case for the further implementation and interpretation of 5 U.S.C. 552. In the public interest, this Court should review the decisions below now before they assume the status of models for federal agency action.[15]

Question 7 concerns the application of Federal Rule 54(c) with respect to which the decisions below are in conflict with decisions of other courts. The range of applicability of Rule 54(c) in 5 U.S.C. 552 cases should be made clear.

The writ should also be granted as to all questions because the relief sought—to wit, public access to more than a century of secret Patent Office precedent—is *per se* of substantial public importance. This Court has consistently held that under the Constitutional scheme, the patent laws have a primary public purpose which may not be subordinated to private interests. The opinion sought will demonstrate whether the Patent Office has in fact administered the patent laws with that primary public purpose foremost. They will disclose why there is a "notorious difference between the [patentability] standards applied by the Patent Office and by the courts" as recognized by this Court in *Graham* v. *John Deere Co.*, 383 U.S. 1, 18 (1966). Hence, whether the unpublished Patent Office precedent from 1853 to the present must be made available is in itself an important public question.

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[15] The "Hearings Before a Subcommittee of the Committee on Government Operations" of the House of Representatives, 89th Cong., 1st Sess. (1965) at pp. 106-107, show that the American Bar Association, which favored enactment of 5 U.S.C. 552 (then denominated S.2335), advanced the view that agencies would not engage in repeated litigation under the Act but would follow the results of a few test cases. This case merits review before relegation to the "test case" status, to resolve its irreconcilable inconsistencies with other relevant precedent and with the words of the Act itself.

A. The Conflict As To Equitable Discretion

In this case, the court of appeals carefully avoided literal reference to "equitable discretion", but excused Patent Office non-compliance with the mandate of 5 U.S.C. 552(a)(2) on equitable grounds *not* "specifically stated in" any part of Section 552.[16] Considering the complaint to request broader relief than 5 U.S.C. 552(a)(2) affords, the court created its own special exemption "for a request . . . made in such general terms as here, involving a large and indefinite number of records which have accumulated over the entire history of [the Patent Office]" (12a). Shorn of euphemism, the June 15 and August 21 decisions below held that if an agency has suppressed a sufficient volume of opinions and interpretations within the scope of 5 U.S.C. 552(a)(2), an assumed difficulty of collecting and producing all of this withheld material outweighs both the statutory command for public availability and the Congressional judgment which prompted it.

In direct conflict with the decision below, the Court of Appeals for the Fourth Circuit, in *Wellford* v. *Hardin*, 444 F.2d 21, 24-25 (1971), squarely held with respect to 5 U.S.C. 552 that:

> "After considering voluminous testimony on both sides and balancing the public, private and administrative interests, Congress decided that the best course was open access to the governmental process with a very few exceptions. *It is not the province of the courts to restrict that legislative judgment under the guise of judicially balancing the same in-*

[16] In its "Brief on Appeal", the Patent Office vigorously contended that equitable discretion should be applied in this case (Brief for the Appellee 11-16).

terests that Congress has considered" (444 F.2d 21, 24-25).[17]

The situation is complicated by the circumstances that a different panel of the Court of Appeals for the District of Columbia earlier *followed Wellford, supra*, in *Getman* v. *National Labor Relations Board*, 450 F.2d 670, 678 (1971), while still another panel of that court even earlier enunciated a rationale similar to *Wellford* in *Soucie* v. *David*, 448 F.2d 1067, 1077 (1971). The June 15 decision below acknowledges its own inconsistency with *Getman* and attempts to distinguish by saying, "there was no problem of identification of the records requested" in *Getman* (8a). In the August 21 opinion, however, it stands admitted that the alleged "problem of identification" is largely illusory, and the inconsistency with "cases which have heretofore been decided by the courts" (12a) is said to be excused by the breadth of petitioner's request. These convenient rationalizations cannot obscure the fact that the court below in this case has *sub silentio* overruled both *Getman* and *Soucie* to adopt the diametrically opposite view of equitable discretion that prevailed in *Consumers Union of United States, Inc.* v. *Veterans Administration*, 301 F.Supp. 796, 801 (SDNY 1969), appeal dismissed as moot, 436 F.2d 1363 (2 Cir. 1971). *Getman*, however, has been before this Court on a motion to stay production, seeking an exercise of equitable discretion and hence may yet be viable. The motion was denied by Mr. Justice Black, who found "no exception in the Information Act which would authorize the Board to refuse promptly to turn over the requested records." *NLRB* v. *Getman*, 404 U.S. 1204 (1971).

[17] The question of agency burden consequent from mandatory disclosure was considered *in extenso* by Congress during the hearings which preceded enactment of 5 U.S.C. 552 and balanced in favor of enacting subsection (a)(2). See, for example, the "Hearings Before the Subcommittee on the Judiciary, United States Senate, 89th Cong., 1st Sess." (1965) at pp. 37, 140, 147-8, 193, 476. See also Petitioner's Brief on Appeal below at pp. 13-26.

Also in conflict with the court below, the District Court for the Northern District of Illinois, in *United States* v. *Leichtfuss*, 331 F.Supp. 723 (1971), recognized that 5 U.S.C. 552 *requires* public disclosure of "manuals, directives, rules and bulletins [which] may . . . contain mistaken interpretations of substantive or procedural laws" (331 F.Supp. at 739). In other words, "any interpretation by way of memorandum or directive of the regulations is subject to disclosure under the Freedom of Information Act. . . ." (331 F.Supp. at 739).[18]

The need to resolve conclusively the question of whether 5 U.S.C. 552(a) is mandatory or discretionary is further demonstrated in "Federal Administrative Law Developments—1971", 1972 Duke Law Journal 115, 139-146.

Moreover, the contention that equity may excuse a federal agency from complying with a valid statute duly enacted by Congress subverts the very concept of equity as consistently implemented in the decisions of this Court. See, *e.g.*, *Virginian Ry. Co.* v. *System Federation No. 40*, 300 U.S. 515, 550-1 (1937) and cases therein cited which fundamentally conflict with the notion that a court of equity has general license to override valid legislation at will.[19]

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[18] Consistent with *Leichtfuss* are a plurality of decisions in the court below and the district court which appear to have been *sub silentio* overruled in this case, including *American Mail Line, Ltd.* v. *Gulick*, 411 F.2d 696, 703 (D.C. Cir. 1969); *Sterling Drug, Inc.* v. *FTC*, 450 F.2d 698, 705 (D.C. Cir. 1971); *Grumman Aircraft Engineering Corp.* v. *Renegotiation Board*, 425 F.2d 578, 580 (D.C. Cir. 1970), on remand 325 F.Supp. 1146 (D.D.C. 1971); *Wecksler* v. *Shultz*, 324 F.Supp. 1084 (D.D.C. 1971).

[19] *Hecht* v. *Bowles*, 321 U.S. 321 (1944), is not to the contrary. Its result rests upon the well known equitable principle expressed in *Virginian Ry. Co., supra*, "that a court of equity may refuse to give any relief when it is apparent that that which it can give will not be effective or of benefit to the plaintiff" (300 U.S. at 550). No such circumstances attend the present case.

B. The Conflict Concerning 5 U.S.C. 552(c) and the Burden to Justify Withholding

A plurality of decisions construing 5 U.S.C. 552 recognize the heavy burden to justify withholding of government information that subsection (c) imposes upon the administrative agencies. Contrary to the decision below, *Cowles Communications, Inc.* v. *Department of Justice*, 325 F.Supp. 726, 727 (N.D. Cal. 1971), holds flatly that "the government should not be allowed to file an affidavit stating that conclusion [*i.e.*, the one sought to be supported] and by so doing foreclose any other determination of the fact". In precisely opposite fashion, the court below relied on the conclusionary (and incorrect) Martin affidavit to foreclose all factual inquiry by petitioner, even in the face of the district court's failure to consider it.

Also in conflict with the decisions below in this regard is *Wellford* v. *Hardin*, 315 F.Supp. 175, 177 (D. Md. 1970), *aff'd* 444 F.2d 21 (1971). In *Wellford*, the government sought to foreclose a plaintiff, *inter alia*, by filing an *ex parte* affidavit alleging that "no identificable record contains information on detentions sought by plaintiff but instead such information is dispersed in many individual files, some of which are in storage. Assembling this information would require the search of many files and be extremely burdensome". In *Wellford*, the district court, construing this self-serving protestation as an admission against interest, summarily found the information sought to be perforce "identifiable", and the protestation of burden to be irrelevant.

In another *Wellford* v. *Hardin* decision, at 315 F.Supp. 768 (D.D.C. 1970), now *sub silentio* overruled by the decisions below, it was held flatly that:

> "It is a violation of the Freedom of Information Act to withhold from the public the means for requesting an 'identifiable record' when those means are

> exclusively within the control of the agency possessing the sought after records".

This holding is in direct contrast with the court of appeals' approval in this case of the district court's summary denial of discovery, including even the right to take the deposition of the affiant, Raymond Martin.

In ordinary civil litigation, moreover, a large body of conflicting case law holds that *ex parte* affidavits made on information and belief or speculation,[20] and those purporting to conclude facts in issue which the opposing party has been foreclosed from exploring,[21] are to be excluded as evidence on summary judgment or otherwise. Its principles were applied in the district court in this case but summarily suspended in the court of appeals.

In addition, conflicting case law governing appellate review of ordinary civil litigation is at odds with the court of appeals in this case. The general rule in ordinary litigation that an appellate court may not make *de novo* fact findings or pass on issues not decided below is typified by *Interpace Corp.* v. *City of Philadelphia*, 438 F.2d 401 (3 Cir. 1971); and *Platt* v. *Minnesota Mining & Mfg. Co.*, 376 U.S. 240 (1964).

Imposition of contrary arbitrary standards on Information Act cases should not be undertaken lightly in the lower federal courts lest public confidence in their fairness be seriously undermined. Review is needed to clarify the substantive and procedural rights of non-agency litigants under 5 U.S.C. 552.

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[20] *E.g.*, *Wellhouse* v. *Tomlinson*, 197 F.Supp. 739 (S.D. Fla. 1961); *Chan Wing Cheung* v. *Hamilton*, 298 F.2d 459 (1 Cir. 1962).

[21] *E.g.*, *Bane* v. *Spencer*, 393 F.2d 108, 109 (1 Cir. 1968); *Toebelman* v. *Missouri-Kansas Pipe Line Co.*, 130 F.2d 1016, 1022 (3 Cir. 1942); *Berne Street Enterprises, Inc.* v. *American Export Isbrandsten Co.*, 289 F.Supp. 195 (SDNY 1968).

C. The Conflict As To The Interpretation Of Rule 54(c)

The August 21 decision below admits that "the final opinions and the orders referred to in Section 552(a)(2), to be made available under published rules are of course identifiable" (12a), but nevertheless affirms the dismissal of this case because "the request is too broad. It is broader than the statutory limits of Section 552(a)(2)" (12a). In direct conflict, the Eighth Circuit, in *Lada* v. *Wilkie*, 250 F.2d 211 (1957), held that "Although part of the relief demanded by plaintiffs could not possibly be granted, the complaint should not have been dismissed, since the question was not whether *all* of the relief asked for could be granted but whether plaintiffs could be accorded any relief." To the same effect as *Lada* are a plurality of other cases, including *Norwalk CORE* v. *Norwalk Redevelopment Agency*, 395 F.2d 920 (2 Cir. 1968); *United States* v. *Howell*, 318 F.2d 162 (9 Cir. 1963); *McHugh* v. *Reserve Mining Co.*, 27 FRD 505 (D. Ohio 1961) and *Asher* v. *Reliance Insurance Co.*, 308 F.Supp. 847, 850 (N.D. Cal. 1970). In aggravation of the conflict with other circuits, the court below has *sub silentio* overruled various of its own contrary decisions, including particularly that in the Information Act case of *Grumman Aircraft Engineering Corp.* v. *Renegotiation Board*, 425 F. 2d 578, 579-80 (1970), wherein the district court's summary judgment was reversed because "the statute does not render the documents *completely* immune from disclosure".

Review should be granted to clarify the status under Rule 54(c) of judgments in Information Act cases and to resolve the conflict in decision.

CONCLUSION

Petitioner respectfully requests that the writ be granted.

Respectfully submitted,

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APPENDIX

APPENDIX

JUNE 15, 1972 DECISION OF THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

Ms. Mary Helen Sears for appellant.

Ms. Barbara L. Herwig, Attorney, Department of Justice, with whom *Mr. L. Patrick Gray, III*, Assistant Attorney General, *Messrs. Thomas A. Flannery*, United States Attorney at the time the brief was filed, and *Walter H. Fleischer*, Attorney, Department of Justice, were on the brief, for appellee, *Mr. Robert V. Zener*, Attorney, Department of Justice, also entered an appearance for appellee.

Before FAHY, *Senior Circuit Judge*, and MACKINNON and ROBB, *Circuit Judges*.

FAHY, *Senior Circuit Judge*: Appellant, plaintiff in the District Court, filed a complaint against the Commissioner of Patents of the United States under the Freedom of Information Act, 5 U.S.C. 552.[1] After partially grant-

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[1] Section 552(a) states in pertinent part:

> Each agency shall make available to the public information as follows:
>
> * * * *
>
> (2) Each agency, in accordance with published rules, shall make available for public inspection and copying—
>
> (A) final opinions, including concurring and dissenting opinions, as well as orders, made in the adjudication of cases:
>
> * * * *
>
> unless the materials are promptly published and copies offered for sale.

5 U.S.C. § 552(a) (1970).

Section 552(a)(3) provides in pertinent part:

> Except with respect to the records made available under paragraphs (1) and (2) of this subsection, each agency, on request for identifiable records made in accordance with pub-

ing the relief sought, the court in terms dismissed the complaint. Appellant sought an injunction prohibiting the Commissioner from refusing to produce as requested "all unpublished manuscript decisions of the Patent Office, together with such indices as are available," [2] and also to require the Commissioner to "maintain and make available for public inspection and copying a current index" of the said manuscript decisions as required by 5 U.S.C. § 552(a)(2). The unpublished decisions have for many years been identified by the Patent Office as manuscript decisions, which are unpublished decisions available in typewritten form to office personnel, but not generally to the public. *See* A. McCrady, *Patent Office* § 116, at 163 (1959). However, patent files and files of any terminated interference involving a patent, or an application on which a patent has issued, are open to the public, 37 C.F.R. § 1.11, but not patent applications which are preserved in secrecy under 35 U.S.C. § 122; 37 C.F.R. § 1.14 (1972).

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lished rules stating the time, place, fees to the extent authorized by statute, and procedure to be followed, shall make the records promptly available to any person. On complaint, the district court of the United States in the district in which the complainant resides, or has his principal place of business, or in which the agency records are situated, has jurisdiction to enjoin the agency from withholding agency records and to order the production of any agency records improperly withheld from the complainant.

5 U.S.C. § 552(a)(3) (1970).

This court in *American Mail Line, Ltd.* v. *Gulick*, 133 U.S. App. D.C. 382, 411 F.2d 696 (1969), held that a party seeking information required to be made available for public inspection and copying by § 552(a)(2), or that required to be published in the Federal Register by § 552(a)(1), but withheld by an agency, can resort to § 552(a)(3) to seek judicial enforcement of §§ 552(a)(1) and (2). *See also Getman* v. *NLRB*, —— U.S. App. D.C. ——, 450 F.2d 670 (1971).

[2] The complaint states that "A substantial portion of the 'final opinions, including concurring and dissenting opinions and orders' . . . are not 'promptly published' nor are copies thereof 'offered for sale' as specified in 5 U.S.C. 552(a)(2)."

The District Court ordered the Commissioner to comply with appellant's prayer that he make available an index of all manuscript decisions rendered since July 4, 1967, the effective date of the Act, conformably with the terms of 5 U.S.C. § 552(a)(2). The Commissioner has not appealed from this order. The ground assigned by the court for dismissing the complaint in other respects is that the request for production was "too broad to be identifiable."[3]

I

The position of the Commissioner in support of the court's action is that the blanket request for all unpublished manuscript decisions does not comply with the provisions of Paragraph (a)(3) that a request be for "identifiable records." The position of appellant is that these unpublished decisions are, in the language of paragraph (a)(2), "final opinions . . . made in the adjudication of cases" and under that provision are to be produced without reference to further identification under paragraph (a)(3).

Our decision in *American Mail Line, Ltd.* v. *Gulick*, *supra*, is contrary to appellant's position. We there said:

> Except with respect to the records made available under paragraph (1) and (2) of this subsection, each agency, on request for identifiable records * * * shall make the records promptly available to any person.
>
> * * * *
>
> We interpret this paragraph [(a)(3)] as meaning that except with respect to records *the agency* has made available under paragraphs (1) and (2) in compliance with that portion of this Act, the agency

[3] The complaint alleges plaintiff's compliance in his request with 5 U.S.C. § 552(a)(3), which provides that except with respect to the records made available under (a)(1) and (a)(2) the request shall be for "identifiable records."

> must make all other identifiable records available (unless exempted by subsection (b)), or face judicial compulsion to do so.

133 U.S. App. D.C. at 387, 411 F.2d at 701.

All manuscript decisions requested by appellant are not published opinions which have been made available by the agency, or final opinions made available for public inspection, under Section (a)(2) "in accordance with published rules" of the agency. Accordingly, under the construction of the Act adopted in *Gulick*, they are to be produced under the process spelled out in paragraph (a)(3), namely, as the result of a request for "identifiable records." What is involved, then, aside from the indices, discussed in Part III of this opinion, is a request for decisions not published or made available by the agency under Section 5 U.S.C. § 552 (a)(2), and identified only as "all unpublished manuscript decisions of the Patent Office." In determining whether this was a request for identifiable records as those terms are to be interpreted, the transcript discloses the following: In support of the Commissioner's Motion to Dismiss or for Summary Judgment, the Associate Solicitor of the Patent Office filed an affidavit which, *inter alia*, states:

> 9. There are more than 3,500,000 files of patents, approximately 100,000 files of patent interferences (terminated or unterminated), approximately 180,000 pending patent applications, and well over a million of abandoned patent applications, any of which may contain one or more manuscript decisions.

Appellant filed a counter affidavit taking issue in numerous respects with various other statements in the affidavit of the Associate Solicitor, but without denying the facts recited in paragraph 9. However, in plaintiff's unverified Statement of Genuine Issues Pursuant to Rule 9(b) it is stated that he "disputes," *inter alia*, that it

would be necessary for the Patent Office personnel to inspect each of the allegedly more than 3,500,000 files referred to in the Associate Solicitor's affidavit, in order to locate the totality of the manuscript decisions sought by the complaint, or to isolate the manuscript decisions which are available to the public. Several additional factual items are important. One of these was developed during the hearings before the District Court. The following colloquy occurred between the court and counsel for plaintiff:

> THE COURT: You are seeking all unpublished manuscript decisions of the Patent Office, is that correct?
>
> MISS SEARS [counsel for plaintiff]: Yes, your Honor.
>
> THE COURT: Couldn't you narrow that. How many opinions do you think are in this category? Could you hazard a guess?
>
> MISS SEARS: I think there are a very large number.
>
> THE COURT: About how many?
>
> MISS SEARS: Many thousands I am quite sure.
>
> THE COURT: And, you are seeking access to all of them?
>
> MISS SEARS: Your Honor, I think the statute requires that the entire public have such access.
>
> * * * *
>
> MISS SEARS: Your Honor, I believe the act requires in so many words that all of the final opinions, the Patent Office Tribunal be made available.
>
> THE COURT: All unpublished opinions.
>
> MISS SEARS: Your Honor, those unpublished opinions are final opinions—Tribunals of the Patent Office.

The record also shows that some of the manuscript decisions are in 170 to 175 volumes composed during the hundred years from 1853 to 1954. It is not disputed

that these volumes are indexed at least to the extent of the volume number in which the decisions appear, with an alphabetical index in each volume of the names of the petitioners and the pages on which the pertinent decisions appear. Since 1954, during which period an undetermined number of such decisions have also been rendered, the volumes have been discontinued.

There accordingly is no genuine factual issue but that the request of plaintiff, as Judge Gasch stated, notwithstanding plaintiff's dispute noted above, was "a broad, sweeping, indiscriminate request for production lacking any specificity," and not a request for records of a "reasonably identifiable description."

The Judge continued, we think justifiably, as follows:

> The plaintiff has not shown that he has been denied any reasonable request for specific material. . . . It may be true that some of these opinions could be made available under the provisions of the Act if a specific request for an identifiable opinion were made, but a request for all is not specific enough to decide if any particular decision or decisions can be made available.

We held in *Bristol-Myers Co.* v. *F.T.C.*, 138 U.S. App. D.C. 22, 424 F.2d 935 (1970), that while the statutory requirement relied upon by the Commissioner, that a request for disclosure specify "identifiable records," is not to be used as a method of withholding records, nevertheless, we continued, the requirement "calls for 'a reasonable description enabling the Government employee to locate the records requested.'" 138 U.S. App. D.C. at 25, 424 F.2d at 938. In light of the facts before the District Court the present request does not seem to us to meet this standard. The case is not one of unwillingness to disclose any identified manuscript decisions but a refusal to make available to appellant all documents described

generally as manuscript decisions which have accumulated over more than a hundred years. We think an obligation to do this is not imposed upon the Commissioner by the request made. As construed in our *Gulick* opinion the Act contemplates that those desiring information not made available to the public under the agency's published rules—all manuscript decisions have not been made available under the rules—must request the desired records with greater descriptive concentration.

We need not decide that the omission of the Patent Office under published rules to have made all final manuscript opinions public, so that they would be available now under Section (a) (2), has been sound policy. Whatever the answer to the problem thus posed, we do not construe the language of paragraph (a) (2) to require the court to order that all such decisions be made available in response to appellant's sweeping and indiscriminate request.[4] Reading paragraph (a) (2) literally, and in isolation from the Act as a whole, appellant's construction that it requires all final manuscript decisions to be made public may be a possible one, but it is not therefore a required one, for,

> Examples are legion where literalness in statutory language is out of harmony either with constitutional requirements, *United States* v. *Rumely*, 345 U.S. 41, or with an Act taken as an organic whole. *Clark* v. *Uebersee Finanz-Korp.*, 332 U.S. 480, 488-489.

Oestereich v. *Selective Service System Local Board No. 11*, 393 U.S. 233, 238 (1968). As the Supreme Court stated in *Lynch* v. *Overholser*, 369 U.S. 704, 710 (1962), the "bare words of a statute" do not control its meaning.

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[4] We have no basis for assuming that the Patent Office has heretofore adopted in bad faith a policy inconsistent in spirit with that now embodied in statutory form in paragraph (a) (2) of the Act.

Our position is, as in *Gulick*, that the request of appellant is subject to and does not meet the requirement of paragraph (a)(3) for identifiable records. While this court in *Getman* v. *NLRB*, *supra*, upheld the District Court in requiring compliance by the National Labor Relations Board with a broad request, there was no problem of identification of the records requested. The language, "all unpublished manuscript decisions of the Patent Office," the terms in which the present request was made, and is still maintained, does describe in general a type of record, but the contours of the records thus described are so broad in the context of the Patent Office files as not to come within a reasonable interpretation of "identifiable records" as this statutory language is used in paragraph (a)(3). All other considerations aside, clearly the request is in terms which seeks records many of which, as Judge Gasch pointed out, may be pending patent applications required to be kept confidential by 35 U.S.C. § 122,[5] read together with Section 552(b)(3).[6]

II

The District Court granted the motion to dismiss the complaint insofar as it covered the request for all unpublished manuscript decisions. Assuming that the court granted the motion to dismiss on the basis of insufficiency of the allegations of the complaint, we think the court was justified in doing so. It appears, however, that the

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[5] Section 122 reads as follows:

> Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

[6] Section 552(b)(3) exempts from disclosure under the Act matters that are otherwise "specifically exempted from disclosure by statute." 5 U.S.C. § 552(b)(3) (1970).

court probably relied upon data not limited to the allegations properly considered on a motion to dismiss. If so, this too was justified because the motion to dismiss was joined with a motion for summary judgment. The action of the court may fairly be construed as a grant of the latter motion as warranted by the law as applied to the facts which present no material factual issue precluding the grant of summary judgment.[7]

III

The order of the District Court does not refer to the allegation of the complaint that plaintiff had requested the Commissioner to make available to plaintiff not only the unpublished manuscript decisions, which we have discussed above, but in addition "such indices as are available." Appellant presses in this court his claim of right to access to the "available indices" of the manuscript decisions, and points out, as we have noted, that the affidavit of the Associate Solicitor acknowledges the existence of indices in some 175 bound volumes containing, according to appellant, manuscript decisions from 1853 to 1954. Construing the request for indices as separate from the request for all manuscript decisions, we think appellant is entitled to a remand for consideration and disposition of this part of the case, which is undecided by the order on appeal. There appears to be some difference between the parties as to the facts regarding these indices. The District Court will have in mind, should the parties be unable to agree, whether these differences

[7] Although during the course of the proceedings in the District Court appellant sought to compel answers to his interrogatories before acting on the Commissioner's motion, it seems that in the end his counsel agreed, in connection with the motion for summary judgment, that the matter was "ripe for disposition on the record as it now appears. Beyond that, as I said before, I am very anxious to have the matter disposed of one way or the other, and that is why I would like very much to simply submit it today [September 21, 1970]," which was done.

preclude disposition of the matter by summary judgment. We of course leave open the question whether the remand for consideration of the request for indices might lead to further light on the request for manuscript decisions themselves, not excluding the possibility of such amendment to the complaint as the District Court may permit in the exercise of a sound discretion should motion to that end be made.

The order on appeal dismissing the complaint insofar as the request for all unpublished manuscript decisions is concerned, is affirmed, and the case is remanded for further consideration and disposition in a manner not inconsistent with this opinion.

It is so ordered.

AUGUST 21, 1972 DECISION OF THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

Before: FAHY, *Senior Circuit Judge*, and MACKINNON and ROBB, *Circuit Judges*.

FAHY, *Senior Circuit Judge*: In his petition for rehearing, appellant suggests that this court mistakenly relied upon *American Mail Line, Ltd.* v. *Gulick*, 133 U.S. App. D.C. 382, 411 F.2d 696 (1969), to support the position that if an agency has failed to comply with 5 U.S.C. § 552(a)(2) to make available its final opinions, and its orders, a party seeking these documents by litigation must comply with the "identifiable" request requirement of 5 U.S.C. § 552(a)(3). Upon further consideration I agree. At the same time I think *Gulick* does not support appellant's request. The opinion in *Gulick* sets forth separately the views of the three judges who decided the case. Two of the judges concurred in holding that the single memorandum there requested under the Freedom of Information Act should be made available as an identified document under Section 552(a)(3) of the Act. The third judge thought the case was moot, and that in any event the memorandum in the circumstances should be made available quite independently of the Freedom of Information Act. It does not appear that the majority concurred in any views as to the Freedom of Information Act except that the memorandum was an identified record and should be made available as such.

Turning in the present case to the Act itself rather than to *Gulick*, we agree that the opinions and orders referred to in Section 552(a)(2), when properly requested, are required to be made available, and that such requirement is judicially enforceable without further identification under Section 552(a)(3), even though the agency has failed to make them available as required by

Section 552(a)(2).* It is implicit in that section, however, that the opinions and orders there referred to are identifiable. The language "identifiable records" appears only in Section 552(a)(3), but this is simply because the final opinions and the orders referred to in Section 552(a)(2), to be made available under published rules, are of course identifiable. For reasons stated in our opinion of June 15, 1972, the present request for "all unpublished manuscript decisions" is not a request for identifiable records considered as made either under Section 552(a)(2) or Section 552(a)(3). Nor is it a request for final opinions, or orders. We accordingly remain of the view that the action of Judge Gasch, considered solely as a grant of the appellee's motion to dismiss, as appellant contends it should be considered, was justified. As the judge pointed out, the request is too broad. It is broader than the statutory limits of Section 552(a)(2).

The District Court did not hold, nor do we, that the manuscript decisions of the Patent Office are exempt, as such, from disclosure. But when a request for them is made in such general terms as here, involving a large and indefinite number of records which have accumulated over the entire history of this agency, the agency and the court are entitled to scrutinize the request more carefully for compliance with the Act than in the usual case, illustrated by those which have heretofore been decided by the courts.

Even assuming that "all unpublished manuscript decisions" requested were final opinions, or orders, those that are not part of pending patent applications are now public records, made so under published rules of the Patent Office, 37 C.F.R. § 1.11 (1972), and those that are

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* See the opinion of Judge Tamm in *Gulick*, 133 U.S. App. D.C. at 387, 411 F.2d at 701.

part of pending applications are required to be kept confidential under 35 U.S.C. § 122 (1970). The former are dispersed, however, among millions of Patent Office files. I do not think the Patent Office was required to reorganize these files in response to appellant's request in the form in which it was made. Nor do I think Congress intended such a result. *Cf.* H.R.Rep. No. 1497, 89th Cong., 2d Sess. 8 (1966); S.Rep. No. 813, 89th Cong., 1st Sess. 7 (1965). There do reside in the record, however, unresolved facts indicative of the existence of compilations of manuscript decisions which may be duplicates of those in the files. Insofar as appellant may make a properly framed request for these, under either Section 552(a)(2) or (a)(3), the District Court no doubt will allow exploration of the facts on our remand for its consideration of the still pending request of appellant for indices. It would seem contrary to the spirit of Section 552(a)(2), which contemplates the availability of final opinions, and orders, made in the adjudication of cases, for an agency to make available for public inspection and copying its final opinions and its orders only in a marginally useful form (*i.e.*, dispersed through millions of public files) and at the same time maintain only for intra-agency use duplicates of the same records in some convenient, compiled and indexed form. In the developments on remand with respect to the indices, it may be that sufficient light will be shed upon the problem to enable a request for the manuscript decisions to be made in a manner which brings it within the Act. *In camera* inspection by the court of the indices and contents of volumes of manuscript decisions which the record indicates may exist, is not precluded, to aid the court in passing upon the issue of disclosure and the related issue of exemptions. With the cooperation of the parties in preserving whatever nondisclosure the exemptions authorize, while at the same time seeking compliance with the purpose of the Act to inform the public as to the manner in which public agen-

cies perform their functions, a satisfactory solution hopefully can be achieved on the remand.

The petition for rehearing is denied.

Judge MacKinnon and Judge Robb concur in the views above expressed and in denial of the petition for rehearing.

ORDER

DATED OCTOBER 23, 1970; ENTERED OCTOBER 26, 1970

This matter is before the Court on the defendant's motion to dismiss or in the alternative for summary judgment. The Court heard both counsel in open Court on September 21, 1970, and at that time afforded both counsel the opportunity to present oral argument on the motion. Both counsel, however, chose to submit the matter to the Court on the pleadings without oral argument.

In this case the plaintiff seeks "all unpublished manuscript decisions of the Patent Office together with such indices as are available" citing the authority of The Freedom of Information Act, 5 U.S.C. § 552(a)(2)(A) and 5 U.S.C. § 552(a)(3). Plaintiff also seeks an order requiring defendant to maintain and make available for public inspection and copying a current index of manuscript decisions as required by 5 U.S.C. § 552(a)(2). "Unpublished office decisions, available to office personnel in typewritten form but not to the public, are called manuscript decisions." McCrady, A. R., Patent Office Practice, p. 163. The Court considered the voluminous papers submitted by the parties and the cases cited. The Court has examined in particular the cases of *Bristol-Myers Company* v. *Federal Trade Commission*, —— F.2d ——, D.C. Cir., No. 22,277, decided March 26, 1970; *Grumman Aircraft Engineering Corporation* v. *The Renegotiation Board*, —— F.2d ——, D.C. Cir., No. 22,635,

decided March 10, 1970; and *Ackerly* v. *Ley*, —— F.2d ——, D.C. Cir., No. 22,665, decided December 19, 1969. *Bristol Myers*, which involved a request to produce certain documents of the Federal Trade Commission relevant to a rulemaking proceeding, required that a request *specify* identifiable records and called for a *reasonable description* enabling the Government employee to locate the requested records. *Grumman*, in which the demand was for the orders and opinions issued during the renegotiation of the contracts of fourteen specified companies during the years 1962-65 and certain documents relating to Grumman's own renegotiation, but in *Grumman* there is no suggestion that the request was not for identifiable records. Neither did *Ackerly* seem to hinge on the question of identifiable records, but was remanded for consideration of the basis of the claim of exclusion under 5 U.S.C. § 552(b)(5).

The request in the instant case "for all unpublished manuscript decisions" is not a reasonable request for identifiable records, but rather a broad, sweeping, indiscriminate request for production lacking any specificity. "All decisions" is not a reasonably identifiable description, any more than asking for all the books in a particular library or all of the unpublished opinions of the United States District Court. The plaintiff has not shown that he has been denied any reasonable request for specific materials—but only a general request for all opinions, some of which may be excludable as trade secret and some of which may not be. It may be true that some of these opinions could be made available under the provisions of the Act if a specific request for an identifiable opinion were made, but a request for all is not specific enough to decide if any particular decision or decisions can be made available.

The papers presented indicate that it is arguable that some of the requested materials contain trade secrets

excludable under 5 U.S.C. § 552(b) (4) or 35 U.S.C. § 122. This Court is not required to examine every manuscript decision of the past 100 or more years to decide in each case if there is trade secret or other material which should be excluded. The legislative history of the Act indicates that it was not the intent of Congress to add materially to the burden of overworked courts. (See 1966 U.S. Code Cong. and Adm. News, pp. 2418-19.) In the case of a specific request for production that had been denied by the Patent Office, the Court could reasonably be expected to examine the claim of exclusion to see if there were any basis. *Grumman* indicated that in some instances where there is a claim of exclusion on the basis of confidentiality that the identifying data could be stricken before the materials were produced.

In view of the fact that it seems probable that some of the manuscript decisions should be made available under the Act if a reasonable request for specific information is made, it is by the Court this 23rd day of October, 1970,

ORDERED that the United States Patent Office maintain and make available for public inspection and copying a current index providing identifying information for the public as to the unpublished manuscript decisions of the Patent Office since July 4, 1967, insofar as the same is required by 5 U.S.C. § 552(a) (2). The Court makes this order so that the public will have an adequate basis on which to make reasonable specific requests of the Patent Office. The Patent Office may deny the request for production of manuscript decisions on other grounds specified in 5 U.S.C. § 552(b) (i.e., trade secret).

The Court, however, finds the request in the present case too broad to be identifiable and for that reason, it is by the Court

ORDERED that the defendant's motion to dismiss be granted except insofar as has already been ordered in regard to the maintenance of a current index.

The Court makes no finding as to whether or not these manuscript decisions are final opinions or whether or not they contain excludable trade secret materials.

/s/ Oliver Gasch, Judge

THE STATUTE INVOLVED

§ 552. Public information; agency rules, opinions, orders, records, and proceedings

(a) Each agency shall make available to the public information as follows:

(1) Each agency shall separately state and currently publish in the Federal Register for the guidance of the public—

(A) descriptions of its central and field organization and the established places at which, the employees (and in the case of a uniformed service, the members) from whom, and the methods whereby, the public may obtain information, make submittals or requests, or obtain decisions;

(B) statements of the general course and method by which its functions are channeled and determined, including the nature and requirements of all formal and informal procedures available;

(C) rules of procedure, descriptions of forms available or the places at which forms may be obtained, and instructions as to the scope and contents of all papers, reports, or examinations;

(D) substantive rules of general applicability adopted as authorized by law, and statements of

general policy or interpretations of general applicability formulated and adopted by the agency; and

(E) each amendment, revision, or repeal of the foregoing.

Except to the extent that a person has actual and timely notice of the terms thereof, a person may not in any manner be required to resort to, or be adversely affected by, a matter required to be published in the Federal Register and not so published. For the purpose of this paragraph, matter reasonably available to the class of persons affected thereby is deemed published in the Federal Register when incorporated by reference therein with the approval of the Director of the Federal Register.

(2) Each agency, in accordance with published rules, shall make available for public inspection and copying—

(A) final opinions, including concurring and dissenting opinions, as well as orders, made in the adjudication of cases;

(B) those statements of policy and interpretations which have been adopted by the agency and are not published in the Federal Register; and

(C) administrative staff manuals and instructions to staff that affect a member of the public;

unless the materials are promptly published and copies offered for sale. To the extent required to prevent a clearly unwarranted invasion of personal privacy, an agency may delete identifying details when it makes available or publishes an opinion, statement of policy, interpretation, or staff manual or instruction. However, in each case the justification for the deletion shall be explained fully in writing. Each agency also shall maintain and make available for public inspection and copying a current index providing identifying information for the public as to any matter issued, adopted, or promul-

gated after July 4, 1967, and required by this paragraph to be made available or published. A final order, opinion, statement of policy, interpretation, or staff manual or instruction that affects a member of the public may be relied on, used, or cited as precedent by an agency against a party other than an agency only if—

(i) it has been indexed and either made available or published as provided by this paragraph; or

(ii) the party has actual and timely notice of the terms thereof.

(3) Except with respect to the records made available under paragraphs (1) and (2) of this subsection, each agency, on request for identifiable records made in accordance with published rules stating the time, place, fees to the extent authorized by statute, and procedure to be followed, shall make the records promptly available to any person. On complaint, the district court of the United States in the district in which the complainant resides, or has his principal place of business, or in which the agency records are situated, has jurisdiction to enjoin the agency from withholding agency records and to order the production of any agency records improperly withheld from the complainant. In such a case the court shall determine the mater de novo and the burden is on the agency to sustain its action. In the event of noncompliance with the order of the court, the district court may punish for contempt the responsible employee, and in the case of a uniformed service, the responsible member. Except as to causes the court considers of greater importance, proceedings before the district court, as authorized by this paragraph, take precedence on the docket over all other causes and shall be assigned for hearing and trial at the earliest practicable date and expedited in every way.

(4) Each agency having more than one member shall maintain and make available for public inspection a rec-

ord of the final votes of each member in every agency proceeding.

(b) This section does not apply to matters that are—

(1) specifically required by Executive order to be kept secret in the interest of the national defense or foreign policy;

(2) related solely to the internal personnel rules and practices of an agency;

(3) specifically exempted from disclosure by statute;

(4) trade secrets and commercial or financial information obtained from a person and privileged or confidential;

(5) inter-agency or intra-agency memorandums or letters which would not be available by law to a party other than an agency in litigation with the agency;

(6) personnel and medical files and similar files the disclosure of which would constitute a clearly unwarranted invasion of personal privacy;

(7) investigatory files compiled for law enforcement purposes except to the extent available by law to a party other than an agency;

(8) contained in or related to examination, operating, or condition reports prepared by, on behalf of, or for the use of an agency responsible for the regulation or supervision of financial institutions; or

(9) geological and geophysical information and data, including maps, concerning wells.

(c) This section does not authorize withholding of information or limit the availability of records to the public, except as specifically stated in this section. This section is not authority to withhold information from Congress. Pub. L. 89-554, Sept. 6, 1966, 80 Stat. 383; Pub. L. 90-23, § 1, June 5, 1967, 81 Stat. 54.

FEDERAL RULE 12(b) AND (c)

(b) HOW PRESENTED. Every defense, in law or fact, to a claim for relief in any pleading, whether a claim, counterclaim, cross-claim, or third-party claim, shall be asserted in the responsive pleading thereto if one is required, except that the following defenses may at the option of the pleader be made by motion: (1) lack of jurisdiction over the subject matter, (2) lack of jurisdiction over the person, (3) improper venue, (4) insufficiency of process, (5) insufficiency of service of process, (6) failure to state a claim upon which relief can be granted, (7) failure to join a party under Rule 19. A motion making any of these defenses shall be made before pleading if a further pleading is permitted. No defense or objection is waived by being joined with one or more other defenses or objections in a responsive pleading or motion. If a pleading sets forth a claim for relief to which the adverse party is not required to serve a responsive pleading, he may assert at the trial any defense in law or fact to that claim for relief. If, on a motion asserting the defense numbered (6) to dismiss for failure of the pleading to state a claim upon which relief can be granted, matters outside the pleading are presented to and not excluded by the court, the motion shall be treated as one for summary judgment and disposed of as provided in Rule 56, and all parties shall be given reasonable oportunity to present all material made pertinent to such a motion by Rule 56.

(c) MOTION FOR JUDGMENT ON THE PLEADINGS. After the pleadings are closed but within such time as not to delay the trial, any party may move for judgment on the pleadings. If, on a motion for judgment on the pleadings, matters outside the pleadings are presented to and not excluded by the court, the motion shall be treated as one for summary judgment and disposed of as provided in Rule 56, and all parties shall be given reasonable opportunity to present all material made pertinent to such a motion by Rule 56.

FEDERAL RULE 54(c)

(c) DEMAND FOR JUDGMENT. A judgment by default shall not be different in kind from or exceed in amount that prayed for in the demand for judgment. Except as to a party against whom a judgment is entered by default, every final judgment shall grant the relief to which the party in whose favor it is rendered is entitled, even if the party has not demanded such relief in his pleadings.

FEDERAL RULE 56(e) AND (f)

(e) FORM OF AFFIDAVITS; FURTHER TESTIMONY; DEFENSE REQUIRED. Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein. Sworn or certified copies of all papers or parts thereof referred to in an affidavit shall be attached thereto or served therewith. The court may permit affidavits to be supplemented or opposed by depositions, answers to interrogatories, or further affidavits. When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of his pleading, but his response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If he does not so respond, summary judgment, if appropriate, shall be entered against him.

(f) WHEN AFFIDAVITS ARE UNAVAILABLE. Should it appear from the affidavits of a party opposing the motion that he cannot for reasons stated present by affidavit facts essential to justify his opposition, the court may refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such other order as is just.

In the Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-502

EDWARD S. IRONS, PETITIONER

v.

COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-10a) and its decision denying reargument (Pet. App. 11a-14a) are not reported. The order of the district court (Pet. App. 14a-17a) is not reported.

JURISDICTION

The judgment of the court of appeals was entered on June 15, 1972. An order denying petitioner's timely motion for reargument was entered on August 21, 1972. The petition for a writ of certiorari was filed on September 27, 1972. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

488-923—72——1

QUESTION PRESENTED

Whether a request for "all unpublished manuscript opinions" of the United States Patent Office is a request for "identifiable records" within the meaning of the Freedom of Information Act (5 U.S.C. 552).

STATUTE INVOLVED

The relevant provisions of the Freedom of Information Act (5 U.S.C. 552) are set forth at Pet. App. 17a–20a.

STATEMENT

This action arose from a request by petitioner, pursuant to the Freedom of Information Act, 5 U.S.C. 552, to inspect "all unpublished manuscript decisions of the Patent Office together with such indices as are available."[1] The Patent Office denied the request on the grounds that the records could not be identified and that disclosure was barred under 35 U.S.C. 122.

Petitioner thereupon brought suit in the United States District Court for the District of Columbia seeking to compel the Patent Office to produce the documents and to maintain and make available for public inspection and copying a current index of manuscript decisions. The action was brought under the Freedom of Information Act which, in pertinent part, requires that "[e]ach agency, in accordance with published rules, shall make available for public inspection and copying—(A) final opinions, including concurring and dissenting opinions, as well as orders,

[1] Manuscript decisions are unpublished typewritten decisions of the Patent Office.

made in the adjudication of cases" (5 U.S.C. 552(a)(2)(A)). The statute also requires that the agency "shall make available for public inspection and copying a current index providing identifying information for the public as to any matter issued, adopted or promulgated after July 4, 1967 * * *" (5 U.S.C. 552(a)(2)(c)).

Where final opinions are not made available and an index is not prepared, the statute provides that the opinion may not be "relied on, used, or cited as precedent by an agency" (5 U.S.C. 552(a)(2)(c)). Pursuant to 5 U.S.C. 552(a)(3) an action may be brought to obtain "identifiable records" of an agency.

The district court ordered the Patent Office to "make available for public inspection and copying a current index providing identifying information for the public as to the unpublished manuscript decisions of the Patent Office since July 4, 1967 * * *" (Pet. 16a). The district court, however, held (Pet. App. 15a) that petitioner's request "'for all unpublished manuscript decisions'" was:

> not a reasonable request for identifiable records, but rather a broad, sweeping, indiscriminate request for production lacking any specificity. "All decisions" is not a reasonably identifiable description, any more than asking for all the books in a particular library or all of the unpublished opinions of the United States District Court. The plaintiff has not shown that he has been denied any reasonable request for specific materials—but only a general request for all opinions, some of which may be excludable as trade secret and some of which may not be. It may be true that some of these opinions

> could be made available under the provisions of the Act if a specific request for an identifiable opinion were made, but a request for all is not specific enough to decide if any particular decision or decisions can be made available.

The district court further noted (Pet. 16a):

> The papers presented indicate that it is arguable that some of the requested materials contain trade secrets excludable under 5 U.S.C. § 552 (b)(4) or 35 U.S.C. § 122. This Court is not required to examine every manuscript decision of the past 100 or more years to decide in each case if there is trade secret or other material which should be excluded. The legislative history of the Act indicates that it was not the intent of Congress to add materially to the burden of overworked courts. (See 1966 U.S. Code Cong. and Adm. News., pp. 2418–19.)

Petitioner appealed from the dismissal of so much of his complaint as requested "all unpublished manuscript decisions" ever rendered by the Patent Office. The court of appeals affirmed.[2] It agreed with the district court that petitioner's request for all unpublished decisions was "too broad" and observed in its opinion denying reargument that (Pet. App. 12a):

[2] The court of appeals noted that there were 175 bound volumes containing manuscript decisions from 1853 to 1954. It remanded to the district court for consideration of petitioner's request for disclosure of indices to these opinions and for any other indices which may be available (Pet. App. 9a–10a, 13a). The court of appeals further noted that it was leaving open the question "whether the remand for consideration of the request for indices might lead to further light on the request for manuscript decisions themselves, not excluding the possibility of such amendment to the complaint as the District Court may permit in the exercise of a sound discretion should motion to that end be made" (Pet. App. 10a).

> The District Court did not hold, nor do we, that the manuscript decisions of the Patent Office are exempt, as such, from disclosure. But when a request for them is made in such general terms as here, involving a large and indefinite number of records which have accumulated over the entire history of this agency, the agency and the court are entitled to scrutinize the request more carefully for compliance with the Act than in the usual case, illustrated by those which have heretofore been decided by the courts.

ARGUMENT

1. Petitioner claims that the court of appeals, although not in terms relying on " 'equitable discretion,' " nonetheless applied that concept in denying relief (Pet. 15). In actuality, however, the court did not apply the equitable discretion doctrine, because it found that petitioner's demand for "all unpublished manuscript decisions" was neither a request for final opinions or orders under 5 U.S.C. 552(a)(2) nor a request for identifiable records under 5 U.S.C. 552(a)(3) (Pet. App. 12a). As the court pointed out (Pet. App. 4a, 13a), a request for "all" such unpublished manuscript opinions involves "a large and indefinite number of records which have accumulated over the entire history of the agency * * *" (Pet. App. 12a). The question whether the courts may decline as a matter of equitable discretion to compel production of

documents sought under the Act is therefore not in issue in the present case.[3]

2. Petitioner also attacks the court's holding that a request for "all unpublished manuscript decisions of the Patent Office" was so broad that it was not a request for identifiable records under 5 U.S.C. 552 (a)(3) (Pet. 8–9). As the court noted, however, the Act contemplates that a demand for records be reasonably specific. There is a tremendous number of manuscript decisions in the Patent Office, all of which petitioner is seeking,[4] and the courts below properly rejected this sweeping demand as lacking in specificity.[5]

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[3] Indeed, the District of Columbia Circuit has rejected, not adopted, the view ascribed to it by petitioner that nondisclosure of specific documents may be justified on equitable grounds despite the fact that they fall within none of the Act's specific exemptions. See *Getman* v. *National Labor Relations Board*, 450 F. 2d 670. Professor Davis has persuasively argued to the contrary. See Davis, *Administrative Law Treatise* 123–24 (1970 Supp.).

[4] Petitioner alleges that the court of appeals erroneously relied on a disputed affidavit in determining that there is a great number of such decisions. Petitioner's counsel herself admitted, however, that she sought access to "a very large number" of documents (Pet. App. 5a). Moreover, the affidavit was not contradicted insofar as it stated that manuscript decisions may exist in millions of files.

[5] Contrary to petitioner's suggestion, there is no conflict among the courts of appeals. *Wellford* v. *Hardin*, 315 F. Supp. 175, 177 (D. Md.), affirmed on other grounds, 444 F. 2d 21 (C.A. 4) (Pet. 18), was a district court decision that a request made for documents containing certain *specified* information was a request for "identifiable records" within the meaning of 5 U.S.C. 552; since the court of appeals did not decide the issue, there is no conflict in circuits. The other case which is allegedly in conflict, *Wellford* v. *Hardin* (II), 315 F. Supp. 768, is only a district court decision; it held that where the

Petitioner contends, however, that since the Patent Office does not have an index of unpublished decisions, he could not identify the documents more specifically. Congress in the Act required agencies to maintain an index of unpublished decisions beginning in 1967, when the Act became effective, and the district court here required the Patent Office to prepare such an index of its unpublished decisions. But Congress declined to require agencies to assume the burden and expense of "identifying" decisions rendered prior to that date. As the House Committee Report (No. 1497, 89th Cong., 2d Sess., p. 8) stated:

> Subsection (b) would help bring order out of the confusion of agency orders, opinions, policy statements, interpretations, manuals, and instructions by requiring each agency to maintain for public inspection an index of all the documents having precedential significance which would be made available or published under the law. The indexing requirement will prevent a citizen from losing a controversy with an agency because of some obscure or hidden order or opinion which the agency knows about but which has been unavailable to the citizen simply because he had no way to discover it. However, considerations of time and expense caused this indexing requirement to be made prospective in application only. * * * As an incentive to establish an effective indexing system, subsection (b) of S. 1160 includes a

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means for identifying records are exclusively within the control of the agency possessing the records, the agency may not deny a request on the ground that the records have not been identified.

> provision that no agency action may be relied upon, used, or cited as a precedent against a private party unless it is indexed or unless the private party has adequate notice of the terms of the agency order.

Congress thus provided a remedy as to pre-1967 opinions, which are not identifiable due to the absence of indices, by precluding the agency from relying upon them. Since the purpose of disclosure of opinions was to make available administrative materials having "the force and effect of law" (H.Rep. No. 1497, *supra*, at p. 7, the remedy provided for the agency's failure to index and identify obviates any prejudice to a litigant before the Patent Office resulting from non-disclosure of material involved in his case. The Freedom of Information Act, however, neither requires the agency to prepare indices of pre-1967 decisions[6] nor justifies the wholesale disclosure of unindexed decisions that petitioner seeks.

3. Petitioner's final contention (Pet. 20) that the court of appeals should have considered whether he was entitled to partial relief, overlooks the fact that the court of appeals remanded so that the district court could further consider this possibility (Pet. App. 10a, 13a).

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[6] It is uncertain what use petitioner would make of hundreds of thousands of manuscript opinions if they were made available to him without an index.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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NOVEMBER 1972.

In the

Supreme Court of the United States

OCTOBER TERM, 1976

No. 75-992

EDWARD E. IRONS,

Petitioner,

v.

COMMISSIONER OF PATENTS,

Respondent.

REPLY BRIEF IN SUPPORT OF PETITION

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-502

EDWARD S. IRONS,

Petitioner,

v.

COMMISSIONER OF PATENTS,

Respondent.

REPLY BRIEF IN SUPPORT OF PETITION

Respondent's brief has eloquently demonstrated that this case merits review in this Court for all of the reasons set forth in the petition. Thus,

1. Respondent has unconvincingly argued that "In actuality . . . the Court did not apply the equitable discretion doctrine" (R. Br. 5) even while acknowledging that the decision is based on a conclusion that the opinions and orders sought pursuant to the mandatory provisions of 5 U.S.C. 552(a)(2) are not "identifiable"—an exception to the statute's ambit created by the courts below in this case.[1] In short, the court below necessarily exer-

[1] 5 U.S.C. 552 expressly "does *not* authorize withholding of information or limit the availability of records to the public, except as specifically stated in this section". Lack of identifiability is *not* "specifically stated".

cised "discretion"—whether or not "equitably"—to decree that while a member of the public *may* be able to compel partial compliance with 5 U.S.C. 552(a)(2) he *cannot* obtain total compliance. *This* exception to the statute's ambit not being among the limited exemptions set forth in 5 U.S.C. 552(b) and hence in derogation of 5 U.S.C. 552(c), its adoption *sub silentio* overrules *Getman* v. *National Labor Relations Board*, 450 F.2d 670 (D.C. Cir. 1971), discussed at R. Br. 6, note 3, in direct conflict with *Wellford* v. *Hardin*, 444 F.2d 21 (4 Cir. 1971), quoted at Pet. 15-16.[2]

To put it shortly, respondent cannot, by any semantic ploy, including the advancement of fine-drawn distinctions between a request for "specific documents" (R. Br. 6, n. 3) . . . "specified information" (R. Br. 6, n. 5) and petitioner's request for all documents contemplated by 5 U.S.C. 552(a)(2) mask the fact that the decisions below fundamentally pose the transcendental problem of whether a duly enacted law of unquestioned constitutionality may be ignored or devitalized in the exercise

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[2] The contention that in *Wellford* "the Court of Appeals did not decide the issue" (R. Br. 6, n. 5) of whether equitable discretion may be invoked to vary or enlarge the exemptions set out in 5 U.S.C. 552(b) is in error. *Per contra*, relying on the language of 5 U.S.C. 552(c), the Fourth Circuit in *Wellford* held that "A broad construction of the exemptions would be contrary to the express language of the Act" (444 F. 2d at 25) and squarely affirmed the district court (315 F.Supp. 175) in *all* respects, including the latter's refusal to exempt records from production as *not* "identifiable"—an exemption *not* set out in the Act.

Note also that Congress has itself reaffirmed all of the legislative judgments underlying 5 U.S.C. 552 in Section 10 of P.L. 92-493, 92nd Cong., 2d Session, enacted October 6, 1972 wherein the limited exemptions to public availability of agency records expressed in 5 U.S.C. 552(b) are specifically incorporated by reference as the *sole* exceptions to public availability of the proceedings of governmental advisory committees. See in this regard particularly the discussion in Senate Report 92-1098, 92nd Cong., 2d Sess. at pp. 14-17.

of administration or judicial "discretion", "equitable" or otherwise. (Pet. 13-14).

2. Further emphasizing that the decisions below were in fact predicated upon an exercise of judicial discretion (whether or not "equitable") respondent argues that the number of decisions sought negates identifiability and hence excuses compliance with 5 U.S.C. 552(a)(2).[3]

Even the Court of Appeals was ultimately not fully satisfied with this "numbers game" approach. In its original decision it relied heavily (Pet. 4a) on Patent Office Solicitor Martin's controverted averments (par. 9) as to the *number* of decisions requested. After petitioner determined in a different case that paragraph 9 is false and so demonstrated on rehearing (Pet. 12, n. 13) the Court of Appeals retreated from its position that numbers alone compel an exercise of judicial discretion to excuse statutory noncompliance. To justify its continued holding of nonidentifiability, it was forced to find, *contrary to fact* on the face of 37 C.F.R. 1.14(b) and (d), that all unpublished manuscript decisions "are now public records" except for those contained in pending patent applications (Pet. 13) with the result that "the Patent Office was [not] required to reorganize" its alleged "mil-

[3] Obviously since the suppressed opinions cover the time span from 1853 to the present there *must* be "a very large number" (R. Br. 6 n. 4). Petitioner does *not* know, however, and has had no opportunity to find out just what the magnitude of the number is since the means for ascertaining that number is exclusively within the control of the Patent Office and petitioner was foreclosed below from discovery to ascertain the true facts in this regard.

The argument that the Martin affidavit "was not contradicted insofar as it stated that manuscript decisions exist in millions of files" (R. Br. 6, n. 4) is a play on words. As is demonstrated *inter alia* at Pet. 12, n. 13, petitioner *did* controvert consistently the inference that "millions of files" would have to be searched in order to find the requested decisions and repeatedly sought the opportunity to so prove in order to place respondent's "burden" argument in true perspective. See also Pet. 16, n. 17 which demonstrates that burden is irrelevant under the Act in any event.

lions of files" (Pet. 13(a)) for the convenience of the public including petitioner.

The whole saga of the "numbers game" approach in the court of appeals vividly demonstrates the need for review by this Court of the procedures invoked below including the district court's summary denial of discovery to petitioner and the appellate court's arbitrary acceptance of the *ex parte* sworn opinions and speculations of Patent Office Solicitor Martin as "evidence" notwithstanding petitioner's timely challenge under Rules 56(e) and (f).[4]

3. The irreconcilability of the decisions below with the agency burden under 5 U.S.C. 552(a)(3) and (c) to justify withholding of information is tacitly confessed by the advancement (R. Br. 7-8) of a *de novo* argument addressed to *this* Court's equitable discretion.

This new argument is to the general effect that the decisions, if produced, would be useless without an index and hence, there should be no public availability under 5 U.S.C. 552(a)(2) of decisions rendered prior to the July 4, 1967 effective date of the mandatory indexing requirement. This argument depends for viability on the

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[4] Had petitioner been permitted discovery in this case the falsity of Martin's paragraph 9 (Pet. 12, n. 13) could have been properly demonstrated on this record prior to appeal.

Moreover, as petitioner's Rule 56(e) and (f) showing demonstrates (A 41-56), timely challenge was consistently made to the other Martin averments. Petitioner *should* have been afforded an opportunity to demonstrate through discovery of facts under the control of respondent that the Martin affidavit contains many inaccuracies. In foreclosing such demonstration the court of appeals *sub silentio* overruled *Wellford* v. *Hardin*, 315 F. Supp. 768 (D.D.C. 1970) as the petition (p. 18-19) notes. Thus, contrary to R. Br. 6 n. 5, this latter *Wellford* case was not advanced to demonstrate a conflict in the circuits but, rather, to demonstrate the abject error into which the District of Columbia circuit has newly fallen *in this case*, in direct conflict with decisions of the courts of other circuits, *inter alia*, in cases cited at Pet. 18-19.

false representation that "Petitioner contends . . . that since the Patent Office does not have an index of unpublished decisions he could not identify the documents more specifically." (R. Br. 7) *But* petitioner has *always insisted* that the Patent Office *does* have at least one—and probably several—still suppressed indices to its unpublished decisions.[5]

Respondent further suggests the availability of the pre-July 4, 1967 decisions could only be of interest to "a litigant before the Patent Office" (R. Br. 8) and irrelevantly questions "what use petitioner would make of hundreds of thousands of manuscript opinions if . . . made available . . . without an index" (R. Br. 8, n. 6). Respondent's true objective in this case—to preserve inviolate from public scrutiny more than a century of secret Patent Office law and *not* to avoid "burden"—thus stands confessed. This purpose is hardly laudatory on the part of *any* Federal agency, much less one which exists, as the Patent Office does, for a *primary public* purpose.[6]

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[5] Respondent has admitted that there exists an index of 1853-1954 decisions in the front of each of the 174 chronological volumes in which those decisions are bound. (Pet. 9a). In addition petitioner believes and has repeatedly sought opportunity to prove below, that an "index" in the form of docket cards for each patent application, interference and appeal, exists internally in the Patent Office and that resort to *this* index would enable easy location by respondent of all material sought without any need to search "millions" of files. See petitioner's Rule 56(e) averments, paragraph 13(d) (A 53-4). Access to the former index has so far been denied below while facts concerning the existence of the latter which are solely within respondent's control remain suppressed with the concurrence of both courts below.

[6] Both Senate Report No. 813, 89th Congress, 1st Session and House Report No. 1497, 89th Congress, 2d Session, particularly recognize that it is a major objective of the Freedom of Information Act to make publicly available the secret law "embodied in thousands of orders, opinions, statements and instructions issued by hundreds of agencies". (House Report, p. 7). The Senate Report particularly

That the public, including petitioner, *is* prejudiced by the continuing secrecy of Patent Office precedent is apparent, *inter alia*, from Doerfer, "The Limits on Trade Secret Law Imposed by Federal Patent and Antitrust Supremacy" 80 *Harvard L. Rev.* 1432, 1444 (1967), as follows:

> ". . . when an examiner's action rejecting an application [for patent] is appealed, only reversals by the Board are available for future citation; rejected applications are kept secret. Since only rejections are appealed the only 'case law' which has developed in the Patent Office is composed of cases in which an examiner has been told that he should have allowed rather than rejected an application. In a future case the examiner cannot cite to the applicant cases in which he has been upheld in rejecting an application. The basic effects are two-fold: not only is the rational growth of a body of law stunted, but all the pressures of cited authority are against rejection and in favor of allowance."

Today the courts are deluged with suits on patents of increasingly tenuous validity and there is a "notorious

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notes that *all* of the material contemplated by the present 5 U.S.C. 552(a)(2) is to be made publicly available, albeit "considerations of time and expense cause . . . [the] indexing requirement to be made prospective in application only." (Senate Report, p. 7). The Senate Report also emphasizes that it is the specific purpose of 5 U.S.C. 552(c) to "make clear beyond doubt that all materials of the government are to be made available to the public by publication or otherwise unless explicitly allowed to be kept secret by one of the exemptions" in 5 U.S.C. 552(b).

As Professor Kenneth Culp Davis has observed "the governing principle [of 5 U.S.C. 552(a)(2)], which I think is without exception, is that secret law is forbidden". *Treatise on Administrative Law*, 1970 Supplement, p. 159. As he noted at the time the Act was passed "its accomplishments in opening up secret law are impressive. The most significant gains from the entire Act are those growing out of the requirement [in 5 U.S.C. 552(a)(2)] of disclosure of six items—orders, opinions, statements of policy, interpretations, staff manuals and instructions". "The Information Act: A Preliminary Analysis, 34 U. of Chicago L. Rev. 761, 804 (1967).

difference" in patentability standards between the Patent Office and the courts as noted in *Graham* v. *John Deere Co.*, 383 U.S. 1, 18 (1966). The question of whether the Patent Office can, on any pretext, continue to suppress its secret law in the teeth of 5 U.S.C. 552(a)(2), obviously merits this Court's attention.

4. *As to Rule 54(c) (Question 7).* There is, of course, no merit to respondent's argument that Rule 54(c) is indirectly satisfied and the conflict with other circuits obviated by "the fact that the court of appeals remanded so that the district court could further consider" the possibility of petitioner's entitlement to at least partial relief. It is futile to suppose that the district court, having already refused the petitioner's request and having been "affirmed" in this denial of relief will now take a different view in face of respondent's continued opposition. Nor, to the extent that the court of appeals may have authorized the district court in the exercise of its own discretion to depart from certain aspects of its prior ruling is there any real compliance with Rule 54(c) which requires that "*every* final judgment *shall* grant the relief to which the party *in whose favor it is rendered is entitled* even if the party has not demanded such relief in his pleadings". The form of "remand" below renders no judgment in favor of petitioner. It contemplates *only* a consideration by the district court of petitioner's request for certain indices plus the "possibility of such *amendment to the complaint* as the district court *may permit in the exercise of a sound discretion* should motion to that effect be made". (Pet. 10a) It thus fails to *guarantee* petitioner relief of any nature. It conditions the relief to which petitioner is tacitly acknowledged to be entitled in this case as it now stands, on the grant of a motion to amend the complaint in contravention of Rule 54(c) and thereby flatly conflicts with the cases cited at Pet. 20.

CONCLUSION

The petition for writ of certiorari should be granted.

Respectfully submitted,

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